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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,107	11/29/2001	Desmond R. Lim	MIT8926	3629
7590 01/21/2005 Samuels, Gauthier & Stevens LLP Suite 3300 225 Franklin Street Boston, MA 02110			EXAMINER FERGUSON, LAWRENCE D	
			ART UNIT 1774	PAPER NUMBER

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/997,107

Applicant(s)

LIM ET AL.

Examiner

Lawrence D. Ferguson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 29 is/are pending in the application.  
4a) Of the above claim(s) 15-28 and 30-44 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-14 and 29 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. This action is in response to the amendment mailed November 15, 2004.

Claims 1, 3-4 and 29 are amended rendering claims 1-14 and 29 pending, with claims 15-28 and 30-44 held to a non-elected invention.

### *Claim Rejections – 35 USC § 103(a)*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scalora (U.S. 6,262,830) in view of Knapp et al (U.S. 6,077,569).

Scalora discloses an optical device (column 2, lines 50-53) comprising a plurality of layers, whereby the layers alternate between low and high index of refraction (column 5, lines 1-10). The reference discloses the material is a conductor of electricity (column 7, lines 50-67) and subsequently heat. Scalora discloses band gaps and their widths (column 5, lines 1-59). The reference discloses an index difference between two index layers greater than 0.3 (column 5, lines 32-35). In claim 1, '...formed by creating alternating layers of said plurality of high index layers and said plurality of low index

layers' is directed to a product by process claim limitation. In claim 9, '...form tunneling junctions between said plurality of high index layer and said low index layers' is deemed to be a product by process claim limitation along with '...fabricated by sputtering said alternating layers' in claim 11. The claim language, '...fabricated by bonding,' '...fabricated by utilizing smart cut technique,' and 'fabricated by utilizing polishing technique' of claims 11-14 are deemed to be product by process claim limitations. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. In claims 7 and 8, '...ensure that the loss in said optical device will be due to scattering off carriers' and '...exhibit low absorption losses' constitutes a 'capable of' limitation and that such a recitation that a device is 'capable of' performing a function is not a positive limitation, but only requires the ability to so perform. Although Scalora does not explicitly teach the plurality of high and low index layers having a relationship,  $E_{g,h} > E_{g,l} > \frac{hc}{\lambda}$ , this relationship is an inherent feature of Scalora's optical device. Mere recitation of a newly-discovered function or property, inherently possessed by things in prior art, does not cause a claim drawn to those things to distinguish over prior art. The Patent Office can require applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted

to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art. Scalora does not disclose Indium Tin Oxides, doped diamonds or silicon. Knapp teaches an optical device comprising alternating layers of high refractive index and low refractive index, where the refractive indices includes indium tin oxide, silicon and diamond materials (column 1, line 34 through column 2, line 9). Scalora and Knapp are analogous art because they are both from the field of optical devices. It would have been obvious to one of ordinary skill in the art to include indium tin oxide, silicon and diamond material in the high index layers of Scalora because Knapp teaches the material provides additional abrasion protection and barrier properties (column 4, lines 11-16).

***Claim Rejections – 35 USC § 103(a)***

4. Claims 1-2 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scalora et al (U.S. 6,343,167) in view of Knapp et al (U.S. 6,077,569) further in view of Duck et al. (U.S. 5,615,289).

Scalora discloses an optical Fabry-Perot device having a band gap structure comprising alternating layers of refractive materials having first and second index of refractions (column 2, lines 8-37) where one layer has an index of refraction of about 3.4 and the adjacent layer has an index of refraction of about 2.9 (column 8, lines 15-24) which results in a difference of 0.5. The claim language, ‘...allow electricity and heat to be conducted’ constitutes a ‘capable of’ limitation and that such a recitation that a

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device is 'capable of' performing a function is not a positive limitation, but only requires the ability to so perform. Although Scalora does not explicitly teach the plurality of high and low index layers having a relationship,  $E_{s,i} > E_{s,e} > \frac{hc}{\lambda}$ , this relationship is an inherent feature of Scalora's Fabry Perot device. Mere recitation of a newly-discovered function or property, inherently possessed by things in prior art, does not cause a claim drawn to those things to distinguish over prior art. The Patent Office can require applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art. Scalora does not disclose Indium Tin Oxides, doped diamonds or silicon. Knapp teaches an optical device comprising alternating layers of high refractive index and low refractive index, where the refractive indices includes indium tin oxide, silicon and diamond materials (column 1, line 34 through column 2, line 9). Scalora and Knapp are analogous art because they are both from the field of optical devices. It would have been obvious to one of ordinary skill in the art to include indium tin oxide, silicon and diamond material in the high index layers of Scalora because Knapp teaches the material provides additional abrasion protection and barrier properties (column 4, lines 11-16). Scalora does not explicitly teach the Fabry-Perot device having mirrors and a cavity.

Duck discloses a Fabry Perot device comprising alternating high and low index regions (abstract and column 1, lines 48-60) including at least two reflectors (mirrors) comprising cavities comprising selective materials (column 1, lines 52-67). All of the

references are analogous art because they are all directed to optical devices. It would have been obvious to one of ordinary skill in the art to include the reflectors (mirrors) comprising cavities with selective materials in the Fabry Perot device of Scalora to reduce the transmission ripple of the device (column 1, lines 50-51).

### ***Response to Arguments***

5. Rejection made under 35 U.S.C. 103(a) as being unpatentable over Scalora (U.S. 6,262,830) is withdrawn due to Scalora lacking a high index degenerately doped material. Arguments to rejection made under 35 U.S.C. 103(a) as being unpatentable over Scalora (U.S. 6,262,830) in view of Knapp et al (U.S. 6,077,569) have been considered but are unpersuasive. Applicant argues Scalora focuses on thickness as a way to tune its transparent window over a wide range of frequencies versus providing a device that can also be thermally and electrically conductive. This argument is an intended use, which is given little patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Applicant further argues the relationship  $E_{gA} > E_{gB} > \frac{hc}{\lambda}$  establishes the parameters for which the invention

will successfully operate. Examiner maintains although Scalora does not explicitly teach the plurality of high and low index layers having a relationship,  $E_{gd} > E_{g\lambda} > \frac{hc}{\lambda}$ , this relationship is an inherent feature of Scalora's optical device. Mere recitation of a newly-discovered function or property, inherently possessed by things in prior art, does not cause a claim drawn to those things to distinguish over prior art. Applicant argues Scalora does not describe the index difference being greater than 0.3. The reference discloses an index difference between two index layers greater than 0.3 (column 5, lines 32-35). Applicant argues there is no discussion the material comprises a high index degenerately doped material and high thermal and electrical conductivity materials. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Knapp teaches an optical device comprising alternating layers of high refractive index and low refractive index, where the refractive indices includes indium tin oxide, silicon and diamond materials (column 1, line 34 through column 2, line 9). Knapp teaches incorporating ITO to include high index degenerately doped material, where the Ag layer in Scalora teaches high thermal and electrically conductive material.

Arguments to rejection made under 35 U.S.C. 103(a) as being unpatentable over Scalora et al (U.S. 6,343,167) in view of Duck et al. (U.S. 5,615,289) has been considered and Knapp et al (U.S. 6,077,569) has been added to teach incorporating ITO to include high index degenerately doped material.





**Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Lawrence Ferguson  
Patent Examiner  
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